

AMENDMENT UNDER 37 C.F.R. § 1.111
U. S. Application No. 09/986,178

REMARKS

Claims 1-9 are pending in the application. Applicant adds new claims 10-16. Claims 1-5 are rejected under 35 U.S.C. § 102(b) as being unpatentable over Chi et al. (U.S. Patent No. 5,121,258) ("Chi"). Claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chi in view of Bonyhard (U.S. Patent No. 6,181,492) ("Bonyhard"). Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chi in view of in view of Ishida et al. (U.S. Patent No. 5,121,258) ("Ishida"). Applicant adds new claims 10-16 to more particularly claim the invention, and to submit the following arguments to traverse the prior art rejections.

Applicant's Invention

Applicant's invention relates to a magnetic transfer method and a magnetic transfer device for magnetically transferring information borne on a master carrier to a slave medium, and to a magnetic medium onto which information is magnetically transferred, in an embodiment. In the embodiment, the master carrier and the slave medium are disposed vertically to prevent the collection of dust the surfaces of the master carrier and the slave medium.

Rejection of Claims 1-5 under § 102(b) over Chi

Chi relates to an apparatus for recording information on a flexible magnetic slave disk by contact transfer of information recorded on a flexible magnetic transfer disk. In rejecting claim 1, the Examiner states that Chi teaches a method of magnetic transfer wherein a slave medium is conveyed in a manner that a recording surface of the slave medium faces vertically toward the master carrier.

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Applicant respectfully submits that claim 1 is patentable because Chi fails to teach each and every element of the claim. For example, nowhere in Chi is there any teaching or suggestion of wherein a slave medium is conveyed in a manner that a recording surface of the slave medium faces vertically toward the master carrier. The drawings do not indicate the vertical and there is nothing to indicate that the magnetic master disk and the slave disks are vertically disposed. Although claim 2 of Chi discloses a pattern of vertical magnetization on the slave disk, there is nothing to indicate that such a pattern would necessarily result in an arrangement where the recording surface of the slave medium faces vertically toward the master carrier, in combination with other elements of claim 1. Rather, col. 6, lines 62-66 of Chi merely describes that the magnetic transfer field effects a pattern of vertical magnetization on the slave disk.

Similarly, claim 4 is patentable for at least the arguments above for claim 1.

Claim 2 is patentable because Chi fails to teach or suggest a method wherein said slave medium is conveyed to a position for close contact with said master carrier, in combination with other elements of the claim. To the contrary, Chi teaches that the slave medium is merely mounted onto the spindle 24, and the member 30 having a magnetic surface 50 is conveyed toward the slave medium (col. 4, lines 9-11). In other words, the slave medium is not conveyed to a position for close contact with the master carrier. Rather, the master carrier is conveyed in Chi.

Similarly, claim 5 is patentable for reasons similar to those presented for claim 2. Nowhere in Chi is there any mention of the slave holder that positions and holds said slave medium and conveys the slave medium to a position for close contact, as claimed in combination

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with other elements of the claim. In Chi, the part characterized as being analogous to the claimed slave holder, the spindle 24, is fixed and does not convey the slave medium.

Further, Chi fails to teach separate slave holder and a pressurizing means as recited in claim 5 with other elements of the claim. The Examiner mentions the spindle 24 as being analogous to the claimed slave holder and the pressurizing means. However, nothing in Chi teaches or suggests that the spindle 24 brings the slave holder and the master carrier in close contact with each other. Due to the aforementioned structural distinctions, claim 5 is patentable.

Rejection of Claims 6 and 7 under § 103(a) over Chi in view of Ishida

Ishida relates to a master information carrier comprising a substrate whose surface has an embossed pattern corresponding to an information signal. Through the use of a suction of air, bolts, and flanges, the hard disk and the information carrier are in contact.

Applicant submits that claims 6 and 7, which ultimately depend from claim 5, are patentable for the reasons submitted for claim 5 and because Ishida fails to make up for the deficiencies of Chi.

Alternatively, or in addition, the references, individually or in combination, fail to teach, suggest, or provide motivation for a plurality of positioning holes and a plurality of positioning pins as recited in claim 6. Ishida does not suggest or provide motivation for pins, but rather teaches the use of bolts. The Examiner must demonstrate that a pin and a bolt are recognized in the relevant art as interchangeable.

Moreover, the Examiner has not established a *prima facie* case of obviousness because one skilled in the art would not be motivated to modify Chi with the bolts and holes taught by Ishida to ensure a uniform contact between the master carrier and the slave disk. Ishida teaches

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the use of bolts and holes in conjunction with flanges to ensure uniform contact along the peripheral portion of the master carrier and the slave disk because the air suction effect is strong at the center section, but weak at the peripheral portions (col. 29, lines 34-48). In Chi, however, the master carrier and the slave disk are each uniformly supported across their surfaces by the pole pieces 18 and 32 to already provide uniform and intimate contact (Fig. 2) by the action of a linear actuator 44 which drives the member 30 (col. 4, lines 17-30). Thus, there would be no motivation for the modification suggested by the Examiner as no additional benefits would arise.

Alternatively, or in addition, claim 7 is patentable because Ishida fails to teach a magnetic transfer device wherein the positioning pins and the positioning holes are partially engaged to perform alignment. To the contrary, Ishida teaches the use of bolts which are fully engaged in threaded holes (Fig. 2).

Rejection of Claims 8 and 9 under § 103(a) over Chi in view of Bonyhard

Bonyhard relates to a method and a structure to create patterns on magnetic disks without the use of servo-writers.

Applicant submits that claim 8 and 9, which depend from claims 1 and 4, respectively, are patentable for at least the arguments submitted for their base claims and because Bonyhard fails to make up for the deficiencies.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,

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